

REMARKS

This is a full and timely response to the outstanding nonfinal Office Action mailed March 27, 2003. Reconsideration and allowance of the application and presently pending claims 1-109 are respectfully requested.

1. Alleged Defective Oath & Declaration for Failure to Include No Deceptive Intent Statement

The present Office Action alleges at paragraph 1 that "the reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414." At paragraph 3 in the Office Action, claims 1-109 are "rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1,175."

The requisite statement that the errors being corrected by the present reissue application occurred without any deceptive intent on the part of the Applicants is included in the COMBINED DECLARATION AND POWER OF ATTORNEY. The Examiner is respectfully referred to the section at page 3, entitled STATEMENT THAT ERROR OCCURRED WITHOUT DECEPTIVE INTENT AND THAT NO NEW MATTER IS ADDED, for the requisite statement wherein the Applicants state that the error "occurred without any deceptive intention on the part of the Applicant." Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1-109 under the basis that the requisite statement that the errors being corrected by the instant reissue application occurred without any deceptive intent on the part of the Applicants is allegedly missing.

2. Alleged Failure of the Applicants to Specify An Error That May Be Corrected by Reissue

The present Office Action alleges at paragraph 2 that the "reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based See 37 CFR U75(a)(1) and MPEP §1414. The statement 'Applicants and Applicants' representatives fail to appreciate the full scope of the invention. Specially, other species of claims, which would have been allowable over the prior art, were not submitted to the Office during the examination of the application that issues as US 6,046,968' is not specify enough to be corrected. Accordingly, it is not considered as a specific error to support the reissue application." At paragraph 3 of the

present Office Action, claims 1-109 are “rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1,175.”

35 U.S.C. §251 states that “whenever any patent is, through error without any deceptive intention, deemed wholly or partially inoperative or invalid, by reason of a defective specification or drawing, or by **reason of the patentee claiming more or less than he had a right to claim in the patent**, the Director shall, on surrender of such patent, reissue the patent for the invention disclosed in the original patent ...” (emphasis added). An inventor’s failure to appreciate the scope of the invention at the time of the original patent grant, and thus an initial intent not to claim the omitted subject matter, is a remedial error. *C.R. Bard Inc. v. M3 Systems Inc.*, 48 U.S.P.Q.2d 1225, 1234 (Fed Cir. 1998).

The requisite statement that the “Applicants believe that U.S. Patent No. 6,046,968 is partially inoperative **by the reason of the patentee claiming less than the patentee has a right to claim in the patent**” (emphasis added) is included in the COMBINED DECLARATION AND POWER OF ATTORNEY. The Examiner is respectfully referred to the section at page 3, entitled STATEMENT OF INOPERATIVENESS, for the requisite statement. Therefore, the Applicants have stated that an error occurred which may be properly corrected by reissue. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1-109 under the alleged basis that none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based.

3. Allegation that the Reissue Application was Made and Sworn To By Assignee and Not the Patentee

“Claims 38-109 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee” at paragraph 4 of the present Office Action.

The instant Reissue Application was not made and sworn to by the assignee, Hewlett-Packard Company. The instant Reissue Application was made and sworn to by the patentees, Daniel Y. Abramovitch and David K. Towner. The Examiner is respectfully referred to the signature pages 3 and 4 wherein the patentees have signed the COMBINED DECLARATION AND POWER OF ATTORNEY. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1-109 under the basis that the instant reissue application was made and sworn to by the assignee and not the patentees.

4. Allegation that the Reissue Application Claims Cannot be Broadened After the Statutory Two Year Period

“Claims 38-109 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application” at paragraph 4 of the present Office Action. More specifically, the present Office Action at paragraph 5, states that “Claims 38-63, 95, 96, 97 and 100-109 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects. The limitation of ‘and re-writing’ was deleted from claims 38, 44, 48, 55, 57, 58, 60, and 95-97 by an amendment filed 12/02/02. This would broaden the scope of claims 38, 44, 48, 55, 57, 58, 60, and 95-97 as compared to that of the original claims in the patent Claims 39-43, 45-47, 49-54, 56, 59-63 and 100-109 fall with their respective parent claim.”

Applicants acknowledge that Examiner’s conclusion that at least one of the claims 38-109 are broader in scope than the claims 1-37 of U.S. Patent No. 6,046,968 issued to the Applicants.

It is well established law that “no reissued patent shall be granted enlarging the scope of the claims of the original patent unless *applied for* within two years from the grant of the original patent” (emphasis added). 35 U.S.C. §251. Courts have interpreted the “applied for” language of 35 U.S.C. §251 such that reissue applications fall generally within three types; reissue applications correcting errors in the specification and/or figures, narrowing reissue applications narrowing the scope of the claims, and broadening reissue applications broadening the scope of the claims.

With respect to a reissue application correcting errors’ courts have clarified that the claims of a pending reissue application correcting errors cannot be broadened after the statutory two year period specified under 35 U.S.C. §251. See, for example, *In re Graff*, 111 F.3d 874, 42 U.S.P.Q.2d 1471 (Fed. Cir. 1997), hereinafter referred to as *Graff*, where the *Graff* applicant filed a reissue application to correct errors to Figure 5 before the end of the two year statutory period. No broadening claims were initially filed. Later, during prosecution of the *Graff* reissue application, and after the expiration of the two year statutory period, the *Graff* applicant submitted broadening claims by amendment. The Examiner properly refused entry of the broadening claims. The court found because the *Graff* reissue application was originally filed to correct errors, and because the two year period of 35 U.S.C. §251 had expired, the public would

not have adequate notice that the *Graff* reissue application sought to broaden claims. Accordingly, the court in *Graff* affirmed the Examiner's rejection of the broadening claims.

However, the situation is entirely different when, within the 35 U.S.C. §251 two year period, the applicant files a broadening reissue application. Public notice that the applicant intends to broaden the scope of the claims is provided when the reissue application includes broadening claims. See, for example, *In re Doll*, 57 C.C.P.A. 822, 419 F.2d 925, 164 U.S.P.Q. 218 (C.C.P.A. 1990), hereinafter referred to as *Doll*, where the *Doll* applicant filed a reissue application to broaden claims before the end of the 35 U.S.C. §251 two year statutory period. Later, during prosecution of the *Doll* reissue application, and after the expiration of the 35 U.S.C. §251 two year statutory period, the *Doll* applicant submitted broadening claims by amendment. *Doll* is discussed in the *Graff* case.

The *Graff* court noted that "the court in *Doll* simply held that the reissue applicant, in the course of prosecution of the reissue application, was not barred from making further broadening changes in the claims" after the expiration of the 35 U.S.C. §251 two year statutory period. *Graff* at 877. Because the *Doll* reissue application was originally filed to broaden claims, the public did have adequate notice that the *Doll* reissue application sought to broaden claims. Accordingly, the court in *Doll* allowed the broadening claims filed after the expiration of the 35 U.S.C. §251 two year statutory period.

The right of an applicant to further broaden claims in a properly filed broadening reissue application by filing even broader claims by amendment, even if after the expiration of the 35 U.S.C. §251 two year statutory period, is also affirmed in *Buell v. Beckstrom*, 22 U.S.P.Q.2d 1128 (B.P.A.I. 1992). The *Buell* reissue applicant asserted that "broadening claims may be presented in a reissue application filed within two years after a patent grant even though such claims were not presented until more than two years after the patent grant and where broader than the original patent claims and the broadened reissue claims originally submitted." *Buell* at 1131. The *Buell* court held in favor of the reissue applicant.

Accordingly, all claims in pending reissue application that were filed before the expiration of the 35 U.S.C. §251 two year statutory period must be considered to determine if at least one of the newly filed claims is a broadening claim. If at least one of the claims are broadening, then the reissue application is a broadening application, and the reissue applicant is entitled to file even broader claims by amendment, even if after the expiration of the 35 U.S.C. §251 two year statutory period. Here, claims 39-99 were filed, by amendment, on November 27, 2001, which precedes the expiration of the 35 U.S.C. §251 two year statutory period of the Applicants' original patent 6,046,968, issued on April 4, 2000. Accordingly, the present reissue

application is a properly filed broadening reissue application. Therefore, the rejection of claims 38-109 under the basis that the broadening claims were filed after the expiration of the 35 U.S.C. §251 two year statutory period must be withdrawn.

5. Allegation that the Reissue Application Claims Improperly Recapture Subject Matter

At paragraph 6 on page 3 of the Office Action, “Claims 38, 42, 43-46, 48, 53, 54, 64, 68, 70 , 72-78, 81, 86, 91 and 92 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.” The Office Action at page 4 further alleges that “a broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.”

More specifically, the Office Action rejects claims 38, 45 and 46 because these claims “include the same limitations in claims 1-3, 8 and 9 surrendered in the application for patent.” Claims 42 and 43 are rejected because they “include the limitations in claims 4 and 5 surrendered in the application for patent.” Claims 48, 64, 81 and 86 are rejected because they “include the same limitations in claims 10 and 11 surrendered in the application for patent.” Claims 53, 54, 68, 70, 91 and 92 are rejected because they “include the limitations in claims 12 and 14 surrendered in the application for patent.” Claims 72-76 are rejected because they “include the limitations in respective claims 12-20 surrendered in the application for patent. Claim 77 is rejected because it “includes the limitations in claims 21 and 22 surrendered in the application for patent. Finally, claim 78 is rejected because it “includes the limitations in claim 23 surrendered in the application for patent.” Apparently, the above claims are rejected because the claims 1-37 of the originally granted patent were surrendered, and therefore recapture rules preclude recapture of that subject matter in later filed claims.

It is well established law that “under the recapture rule, a patentee ordinarily is barred from securing through reissue a claim that is the same or of broader scope than those claims that were *canceled or narrowed by amendment during prosecution* of the original patent” (emphasis added). *Patecell v. United States*, 16 Cl. Ct. 644, 12 U.S.P.Q.2d 1440, 1445, 1447 (Cl. Ct. 1989). Claims 1-37 were surrendered as part of the reissue application filing process. Claims 1-37 were not cancelled or narrowed. Accordingly, a rejection of any of the claims 38-

109 cannot be maintained under an allegation that recapture rules apply because the rejected claims “include the limitations in” a claim “surrendered in the application for patent.”

Proper rejection of a claim requires that the scope of each of the claims be analyzed with respect to any claim amendments *made during prosecution* of the original application. For example, the limitation of “and re-writing” was added by amendment during prosecution to claim 1. Arguably, this amendment had the effect of narrowing claim 1. However, this particular limitation *was not* added by amendment, or originally included in, issued independent claims 10, 24, 36 and 37. Furthermore, this particular limitation *was not argued during prosecution as necessary to overcome a rejection based on cited art.* The “and re-writing” limitation of claim 1 was added by amendment during prosecution to merely better define one particular embodiment of the Applicants’ invention. Other embodiments do not include this particular limitation. Accordingly, recapture provisions do not apply to any of the newly added claims 38-99 that do not happen to include this particular limitation.

Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 38, 42, 43-46, 48, 53, 54, 64, 68, 70, 72-78, 81, 86, 91 and 92 based upon an allegation of improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Furthermore, Applicants believe that newly added claims 38-109 are not subject to recapture provisions based upon any claim amendments made during prosecution of the original application.

However, if in the next Office Action the rejection of any of the claims 38, 42, 43-46, 48, 53, 54, 64, 68, 70 , 72-78, 81, 86, 91 and 92 is maintained based upon an allegation of improper recapture, Applicants respectfully request that the Office Action specify with particularity the basis of any such rejection. More particularly, the Applicants would like to know specifically *where in* the history record any alleged subject matter was surrendered by the Applicant. The process for specifying this information to the Applicants is discussed in detail in MPEP §1412.02.

6. Request for Information Disclosure

At paragraph 7 on page 5, the Office Action indicates that “the Applicant should submit the IDS which has all reference(s) cited in the parent application.” Applicants submit the requested IDS that includes all references cited in the parent application.

7. Acknowledgement of Allowed Claims and Subject Matter

Applicants acknowledge the Examiner's allowance of claims 1-37, as noted in paragraph 8 of the Office Action.

8. Discrepancy Regarding Paper Number Designation

In the Office Action Cover Sheet, the present Office Action is identified as paper No.

5. However, in the Office Action Summary Sheet and thereafter, the present Office Action is identified as paper No. 4. Applicants respectfully request clarification as to the correct paper number of the present Office Action.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-109 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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